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| 10/071,701      | 02/08/2002  | David Z. Lubowski    | 5804.02             | 2673             |

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INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

LEUBECKER, JOHN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 04/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/071,701

Applicant(s)

LUBOWSKI, DAVID Z.

Examiner

John P. Leubecker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-24, 28-43 is/are rejected.
- 7) ☒ Claim(s) 25-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose that the contamination prevention means, which is described as, for example, a one-way valve, filter or tortuous path (page 12, line 20 to page 13, line 8 and page 18, line 17 to page 19, line 3), can insulate a reusable light source from being exposed to any contaminated insufflation medium. The contamination prevention means is only effective in preventing contamination of the insufflation means and associated tubing.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11, 18-20, 38, 40 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites a function of the contamination prevention means (i.e., preventing contamination of the light source by the insufflation medium) that is not described in the specification (note page 12, line 20 to page 13, line 8). It is therefore unclear as to what structure Applicant is intending to claim. Furthermore, it appears that claim 11 is redundantly reciting the function of the contamination preventing means of claim 43, from which it depends.

Claim 18, as it depends from claim 10, refers to “the contamination prevention means” which lacks antecedent basis.

Claim 19, as it depends from claim 10, refers to “the contamination prevention means” which lacks antecedent basis.

Claim 20, as it depends from claim 10, refers to “the contamination prevention means” which lacks antecedent basis.

As to claim 38, relative term “good” with respect to transmission properties is indefinite since the requisite degree of “good transmission properties” can vary dependent on the interpreter of the term.

Claim 40 further recites an additional “insufflation means”. It appears that this claim should be further limiting the insufflation means previously recited.

Claim 43 recites a function of the contamination prevention means (i.e., insulating the reusable light source from being exposed to any contaminated insufflation medium) that is not

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described in the specification (note page 12, line 20 to page 13, line 8). It is therefore unclear as to what structure Applicant is intending to claim. For the purposes of examination of claims dependent from claim 43 that refer to the originally disclosed contamination prevention means (e.g., claims 2-8), the examiner will interpret the contamination prevention means in claim 43 as defined by the disclosure.

Dependent claims inherit those defects.

***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 41, 42, 10, 15-17, 21, 22, 23, 24 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Fiore (U.S. Pat. 3,889,661).

Fiore disclose a disposable speculum (11) which is substantially rigid, has two ends and a lumen extending between the ends, a connection means (26), and a insufflation means (col.6, line 63 to col. 7, line 3) with a gas conveying tube (34). As to claim 42, window (18) provides a gas-tight window disposed between the lumen and the connection means (Fig.1). As to claims 10 and 17, any of the components, including the insufflation means and eyepiece (33) are disposable. As to claims 15 and 16, the inlet duct described in col. 6, line 63 to col. 7, line 3 can be considered to be “associated” with either the speculum or the eyepiece since these components are all connected. As to claims 21-24, note obturation means (21,22) in Figure 1.

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8. Claims 41, 42, 10, 15-17, 21-24 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Saslow (U.S. Pat. 3,889,661).

Saslow disclose a disposable speculum (41) which is substantially rigid, has two ends and a lumen extending between the ends, a connection means (27), and a insufflation means (40 or 51) with a gas conveying tube (49). As to claim 42, note gas-tight window (79) (col. 4, lines 47-53). As to claims 10 and 17, any of the components, including the insufflation means and eyepiece (note 29) are disposable. As to claim 15 and 16, inlet duct (47) can be considered to be "associated" with either the speculum or the eyepiece since these components are all connected. As to claims 21-24, note obturation means (37,59).

***Allowable Subject Matter***

9. Claims 2-9, 11-14, 18-20 and 28-39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Assuming that the contamination prevention means of claim 43 is encompassing what is disclosed in the specification (an equivalents thereof), this claim would also be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. It is also noted that claims 15, as dependent on claims 2, 11 or 12; claims 16 and 17, as dependent on claims 2, 11 or 12; and claims 21-24, as dependent on claims 2, 11 or 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second

paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims, as they ultimately depend from claim 43.

11. Claims 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

12. Applicant's arguments filed January 20, 2004 have been fully considered but they are not persuasive. Although Applicant amended the claims to obviate the rejection over the Opie et al. reference, Applicant has failed to provide an independent claim that reads over other prior art references of record. Accordingly, rejections of certain claims appear above.

#### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

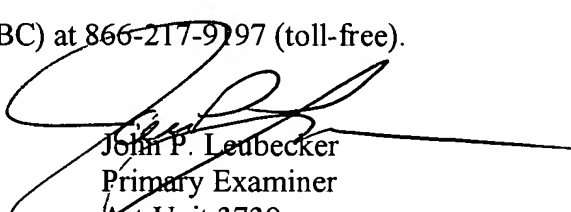
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl